



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/734,297 | 12/15/2003 | Hitoshi Ohgane | 106145-00075 | 4710 |

7590 02/02/2007
ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
Suite 600
1050 Connecticut Avenue, N.W.
Washington, DC 20036-5339

| |
|----------|
| EXAMINER |
|----------|

YOON, TAE H

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1714

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 02/02/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/734,297

Applicant(s)

OHGANE ET AL.

Examiner

Tae H. Yoon

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Komatsu et al (US 6,096,378).

The instantly recited 'a multilayer paint substitute film comprising' encompasses a painted film on a substrate having additional layers, and the preamble alone has little probative value.

Komatsu et al teach a multilayer film comprising a primer, a coloring base coating and a clear coating in abstract. Said primer would meet the instant adhesive layer inherently since it would adhere on a substrate. Said coloring base coating comprises a titanium white pigment (orientation inhibitor) and an aluminum flake (metallic pigment). Titanium oxide is taught as an extender at page 6, lines 21-25 of the instant specification. Komatsu et al also teach employing an extender pigment in said coloring base coating at col. 4, lines 50-55.

Komatsu et al also teach an intermediate coating containing fine aluminum powders (metallic pigment). having an average particle diameter of 3-7 μm and titanium

oxide pigments (can be coated with alumina or silica, orientation inhibitor) having an average particle diameter of 5 μm or less at col. 3, lines 15-45, and said intermediate coating also would meet the instant color coat layer.

Thus, the invention lacks novelty.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as obvious over Komatsu et al (US 6,096,378) and McCarthy et al (US 5,989,696).

The instant invention further recites glass bead and powder over Komatsu et al who teach employing an extender pigment in said coloring base coating. McCarthy et al teach hollow glass as one of extender pigments at col. 2, line 59, and said hollow glass is glass bead since it is sphere.

Thus, it would have been obvious to one skilled in the art at the time of invention to utilize said hollow glass of McCarthy et al as an extender pigment in said coloring base coating of Komatsu et al since Komatsu et al who teach employing an extender pigment in said coloring base coating and since said hollow glass is known as one of extender pigments absent showing otherwise.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as obvious over JP 2000-085075.

JP teaches a multilayer coating substitution film comprising a transparent layer, a colored layer and an adhesive layer in abstract. Said colored layer would contain

various mixtures of pigments such as titanium oxide and aluminum flake (see [0012] of English translation) meeting the instant invention.

Thus, it would have been obvious to one skilled in the art at the time of invention to utilize a mixture of titanium oxide and aluminum flake in said colored layer of JP since JP teaches such modification.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as obvious over JP 2000-085075 in view of Komatsu et al (US 6,096,378) or JP 2002-294163.

The instant invention further recites an average particle diameter of an orientation inhibitor such as titanium oxide over JP'075, and Komatsu et al teach titanium oxide having an average particle diameter of 5 μm or less as discussed above. JP'163 teach the same in [0013]-[0014].

Thus, it would have been obvious to one skilled in the art at the time of invention to utilize a mixture of titanium oxide having an average particle diameter of 5 μm of Komatsu et al or JP'163 and aluminum flake in said colored layer of JP'075 since JP'075 teaches use of such mixture and since use of titanium oxide having an average particle diameter of 5 μm or less in a coating is well known practice in the art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tae H Yoon
Primary Examiner
Art Unit 1714

THY/January 29, 2007